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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,671	01/18/2001	Jeffrey Scott Eder		5378
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JEFF EDER 19108 30TH DRIVE SE MILL CREEK, WA 98012				
EXAMINER RETTA, YEHDEGA				
ART UNIT 3622				
PAPER NUMBER				

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/761,671

Applicant(s)

EDER, JEFFREY SCOTT

Examiner

Yehdega Retta

Art Unit

3622

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 January 1934.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1 and 12 are objected to because of the following informalities: spelling error, "to identity". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 recites the limitation "The enterprise modeling method of claim 1" in page 3.

There is insufficient antecedent basis for this limitation in the claim. Correction is required.

Claim 8 recites the limitation "The enterprise modeling method of claim 3" in page 3.

There is insufficient antecedent basis for this limitation in the claim. Correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 and 32-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological art; and

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(2) whether the invention produces a useful, concrete, and tangible result.

For claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical science as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For the process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

The independently claimed steps of claims 1 and 32, aggregating data and identifying factors or quantifying impact, do not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory patent protection. The claimed step of aggregating data and identifying factors or quantifying does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of user or by use of a pencil and paper. Claims reciting those steps can be performed by interpersonal communications such that the claimed steps can be performed without a physical structure or mechanical object. The method only constitutes an idea for identifying factors. Since the claimed invention, as a whole, is not with the technological art as explained above, the claims, are deemed to be directed to non-statutory matter.

Claims 1-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Regarding claims 1, 12, 24 and 32, for a claimed invention to be statutory the claimed invention must produce a useful, concrete and tangible result. Since in the present case, the claimed invention does not produce useful and tangible result, the claims are deemed to be directed to non-statutory matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by “Valuation of Accounting Practices: What’s it Worth?” Reilly, Robert R.; Schweihs, Robert P. National Public Accountant; v36n2; pp: 20-29; Feb 1991. Hereinafter Reilly.

Regarding claims 1, 2, 6-10, Reilly teaches aggregating enterprise related data from a variety of sources and identifying the factors that affect enterprise intellectual capital such as brands, customers, employees, intellectual property, etc.; identifying the interrelationship between the factors; data obtained from advanced financial system, basic financial system, etc., financial performance selected from revenue, expense etc.; wherein the enterprise is a division or company...(see Page 1-4).

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Regarding claims 3-5, Reilly teach creating summary of the impact that are a function of the inter-relationship between the factors that affect the capital to create models to perform analyses (see page 6-9).

Claims 1-10, 12-15, 17-21, 23-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Harhen U.S. Patent No. 5,406,477 and Apgar, IV U.S. Patent No. 5,680,305.

Regarding claims 1-10, 12-15 and 17-21, 23-34, both Harhen and Apgar teaches aggregating enterprise related data from a variety of sources and using a portion of the data to identify the factors that affect the enterprise capital; identifying inter-relationship between the factors; creating summaries of the impact... (see Harhen col. 4 line 50 to col. 5 line 20 and col. 9 line to col. 13 line 32; see Apgar abstract and col. 7 line 1 to col. 13 line 55).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly as applied to claim 5 above, and further in view of Official Notice.

Regarding claim 11, Reilly does not teach the use of Markov Chain Monte Carlo model to identify changes that will optimize one aspect of the enterprise performance. Official Notice is taken that is old and well known to use such model for optimization, in the art of business. It

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would have been obvious to one of ordinary skill in the art at the time of the invention to use such simulation model in order to predict and optimize the performance.

Claims 11, 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harhen or Apgar and further in view of Official Notice.

Regarding claim 16, both Harhen and Apgar do not teach identifying changes to capital that will optimize financial performance... However, Official Notice is taken that is old and well known in the art of business valuation to perform analyses to identify changes that will optimize performance of enterprise. It would have been obvious to one of ordinary skill in the art at the time of the invention to perform such analyses in order to evaluate strategic option that best satisfies customer's desired outcomes.

Regarding claims 11 and 22, both Harhen and Apgar do not teach the use of Markov Chain Monte Carlo model to identify changes that will optimize one aspect of the enterprise performance. Official Notice is taken that old and well known to use such model for optimization in the art of business. It would have been obvious to one of ordinary skill in the art at the time of the invention to use such simulation model in order to predict and optimize the performance.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hartnett, U.S. Patent No. 6,6064,971 teaches Adaptive knowledge base.

Eder U.S. Patent No. 5,615,109 teaches method for generating feasible, profile maximizing requisition sets.

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Valuation of intangible assets for property tax purposes; Rabe, James G, Reilly, Robert F.; The Nation Public Accountant, Washington; Apr 1994. Vol. 39, Iss. 4; pg. 26, 5 pgs.

Valuation of a Closely Held Business; Hitchner, James R. The Tax Adviser, New York: Jul 1992. Vol. 23, Iss. 7; pg. 471, 9 pgs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yehdega Retta  
Examiner  
Art Unit 3622

YR